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Robert Salinas

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EXAMINER

CHORNESKY, ADAM B

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,551

Applicant(s)

SALINAS, ROBERT

Examiner

ADAM CHORNESKY

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-19, 25, 28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-19, 25, 28, and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a Final Office Action in response to the Amendment filed on January 08, 2009. Claims 1-12, 20-24, 26, 27, 30 and 31 have been cancelled. Claims 13-19, 25, 28 and 29 are currently pending and have been considered below.

Claim Rejections - 35 USC § 101

2. Claim 13 and the dependent claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to a particular machine or apparatus nor physically transform underlying subject matter (such as an article or materials) to a different state or thing. See also, United State Court of Appeals for the Federal Circuit, 2007-1130, (Serial No. 08/833,892) *IN RE BERNARD L. BILSKI and RAND A. WARSAW*.

In claim 13, the steps of “receiving at least one input from a player...,” “displaying at least one graphical object...,” “displaying at least one visual effect,” etc. should individually incorporate a particular machine (computer, apparatus or hardware per se); otherwise it can be

concluded, under a broad interpretation, that those steps were manually performed. Here, to be statutory, under USC 101, at least one non-trivial step should incorporate or should be performed using a particular machine (computer, apparatus or hardware per se). The Examiner further notes that the steps of receiving input and displaying data are considered to be trivial steps. The non-trivial portion of the claim appears to be the steps described in the “wherein” clause in which the player selects a product and an operational parameter of the game is modified. However, these need to be recited in the active tense and tied to a specific machine, such as a computer processor, e.g. “receiving by the computer processors a selection of a product from the player, and modifying by the computer processor an operational parameter of the electronic game.”, or similar language supported by the specification.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 13-19, 25, 28 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Rashkovskiy (US Pat 6616533 B1).

Claim 13: Rashkovskiy discloses a computer-implemented method for promotion of products within an electronic game or simulation, comprising the steps of:

receiving at least one input from a player, whereby the player is identified (col. 2, lines 20-34 via the user mouse clicks on an icon to purchase the imaged item using a shopping card software system);

displaying at least one graphical object corresponding to a promoted product (col. 4, lines 58-67 via ad scoring software determines whether an object is clicked on by the user);

displaying at least one visual effect with respect to the graphical object, whereby the promoted product is brought to the attention of the player by the visual effect (col. 4, lines 58-67 via if the clicked upon object is hot clickable, the game may be paused);

wherein the promoted product has a label or tag that identifies a brand (abstract via once the game play is paused, an advertising graphical user interface may be displayed that enables the user to purchase items associated with image elements observed in the course of game play); and

in response to at least one action being performed by the player, the promoted product is selected by the player and modifying an operational parameter of the electronic game is modified (col. 3, lines 18-35 via information about image elements in the game that are not hot clickable that have been mouse click selected may be collected and provided to a web server, and the owner of the web server can develop additional products sold through additional products sold through additional hot clickable elements).

Claim 14: Rashkovskiy discloses all the elements of claim 13, and further discloses wherein the operational parameter is the player's speed (col. 4, lines 58-67 and Fig. 9 via the ad scoring software 92 determines whether a certain score level has been achieved in the course of a video game, and if so, the software 92 determines whether an object is clicked on by the user [the Examiner construes that the speed of a player determines whether the player can access these clickable objects]).

Claim 15: Rashkovskiy discloses all the elements of claim 13, and further discloses wherein the operational parameter is the player's power (col. 4, lines 58-67 and Fig. 9 via the ad scoring software 92 determines whether a certain score level has been achieved in the course of a video game, and if so, the software 92 determines whether an object is clicked on by the user [the Examiner construes that the player's gaming power determines whether the player can access these clickable objects]).

Claim 16: Rashkovskiy discloses all the elements of claim 13, and further discloses wherein the operational parameter is the player's dexterity (col. 4, lines 58-67 and Fig. 9 via the ad scoring software 92 determines whether a certain score level has been achieved in the course of a video game, and if so, the software 92 determines whether an object is clicked on by the user [the Examiner construes that the player's gaming dexterity determines whether the player can access these clickable objects]).

Claim 17: Rashkovskiy discloses all the elements of claim 13, and further discloses wherein the operational parameter is the player's the endurance (col. 4, lines 58-67 and Fig. 9 via the ad scoring software 92 determines whether a certain score level has been achieved in the course of a video game, and if so, the software 92 determines whether an object is clicked on by the user [the Examiner construes that the player's gaming endurance determines whether the player can access these clickable objects]).

Claim 18: Rashkovskiy discloses all the elements of claim 13, and further discloses wherein the method comprises the additional step of recording and transmitting data relating to the promoted product selected by the player to a remote computer (col. 2, lines 58-65 via when a user clicks on an image element, the graphical user interface may be downloaded over the Internet from a web site whose URL is used to automatically obtain the information to build the interface).

Claim 19: Rashkovskiy discloses all the elements of claim 13, and further discloses wherein the method comprises the additional step of recording and transmitting data relating to the player to a remote computer (col. 4, lines 58-67 via the ad scoring software determines whether the player has achieved a certain score level in the course of playing a video game, and if so, determines whether an object is clicked on by the player in the course of the game).

Claim 25: Rashkovskiy discloses a computer system comprising:

at least one display and at least one input device; at least one processor in communication with the display; at least one storage medium in communication with the processor (col. 3, line 63 through col. 4, line 15 and Fig. 4 via a processor 46 ... a system memory 50 coupled by a bridge to a graphics accelerator 54 ... a bridge 48 coupled to a bus 58 ... an audio accelerator 64 ... connected to a sound system 68 ... a hard disk drive 66 that is connected to a sound system 68);

wherein the processor operates a promotion engine based in part on instructions stored on the storage medium (col. 4, lines 6-15 and Fig. 4 via ... the hard disk drive 62 may store information from electronic recordable media that cause the game to be displayed on the user's display 56 [the Examiner has already shown *supra* how the game is a promotion engine]);

wherein the promotion engine conducts at least one promotion whereby during play of a game or simulation at least one graphical object corresponding to a promoted product is displayed on the display (abstract via a video game associated with advertising such that when the player mouse clicks on an image element in the course of play of the game, the game play may automatically be paused, and once paused, an advertising graphical user interface may be displayed that enables the user to purchase items associated with image elements observed in the course of game play); and

wherein the input device is capable of receiving input from a player in response to the promotion (abstract via the input device is the mouse),

whereby the computer system is capable of determining that the input from the player indicates that the player selected the promoted product and of modifying the instructions with respect to at least one operating parameter (abstract via the user clicking on an image element is the selection of the promoted product).

Claim 29: Rashkovskiy discloses all the elements of claim 25 and further discloses wherein the promotion engine conducts at least one promotion after a player completes play of a computer game or simulation (col. 4, lines 39-52 and Fig. 6 via game ad software may be utilized to provide an advertising at the end of the game in response to a user selection in the course of playing the game).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rashkovskiy (US Pat 6616533 B1) in view of Official Notice.

Claim 28: Rashkovskiy discloses all the elements of claim 25, but does not disclose wherein the promotion engine conducts at least one promotion before a player commences play of a computer game or simulation. However, Official Notice is taken that it was old and well

known for electronic games to present promotions before the commencement of the game. for example, manufacturers of video games commonly display a "splash" or advertisement page after a user clicks on the game icon to bring up the game. In the 1990's the makers of the computer video games, such as DOOM™, Donkey Kong™, Pac-Man™, Mortal Kombat™, etc., presented the player with an introductory page, which is in fact, an advertisement. Other games such as Quake™ and Myst™ also appeared during the same time period. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to display one or more advertisements before the game in Rashkovskiy begins. One would have been motivated to display advertisements before, during, and after game play in order to encourage the player to purchase more products and to entice the user to play the game in the first place.

Response to Arguments

7. Applicant's arguments filed June 27, 2008 with respect to claims 13-19, 25, 28 and 29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Chu (US PgPub 20040148221 A1) teaches an online game advertising system for enabling the definition, sales, distribution, and management of interactive advertisements, sponsorship, and placement.

- b. Ebisawa (US Pat 5946664 A) teaches an apparatus and method for executing a game program having advertisements therein.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM CHORNESKY whose telephone number is (571)270-5103. The examiner can normally be reached on Monday - Thursday 7:30 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571-272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A. Chornesky
April 7, 2009

/James W Myhre/
Supervisory Patent Examiner, Art Unit 3688